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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,366	09/08/2003	Anthony J. Baerlocher	0112300-1630	9500
29159	7590	03/18/2008	EXAMINER	
BELL, BOYD & LLOYD LLP			MOSSER, ROBERT E	
P.O. Box 1135				
CHICAGO, IL 60690			ART UNIT	PAPER NUMBER
			3714	
			NOTIFICATION DATE	DELIVERY MODE
			03/18/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATENTS@BELLBOYD.COM

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/657,366	BAERLOCHER, ANTHONY J.
	<b>Examiner</b>	<b>Art Unit</b>
	ROBERT MOSSER	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 2/12/2008.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-23, 26, 37-42, 46-48 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 8 and 46-48 is/are allowed.

6) Claim(s) 1-7,9-23,26 and 37-42 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____ .	6) <input type="checkbox"/> Other: _____ .



## DETAILED ACTION

### ***Allowable Subject Matter***

Based upon the review of the prior art and the present claim scope the indicated allowability of claims **1-7, 9-23, 26, and 37-42** is withdrawn in view of the reference(s) to Yoseloff et al and Singer et al. Rejections based on the cited reference(s) follow.

Claims **8** and **46-48** are allowed. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does teach or suggest the transformation of a flanking symbols into convertible symbols and vise versa between subsequent game plays.

### **Claim Interpretation**

Claims **1-11, 13-23, 26, 37-42, and 46-48**, define a symbol transformation arrangement that includes a subset of a generic wild symbol transformation game however, these claims fail to preclude the remainder of a generic wild symbol transformation. For instance while the claims establish the transformation of a convertible symbol when flanked by two flanking symbols the transformation of the convertible symbol the claim language does not positively recite any claim limitations that would prohibit other symbol arrangements from effecting the transformation of the convertible symbol.

Additionally the presentation of a flanking symbol and a non-convertible symbol are not presented by the applicant in such manner that these symbols would be

exclusive to one another. Accordingly the flanking symbols and non-convertible symbols are understood to include symbols that serve as both flanking and non-convertible symbols.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 sets forth the presentation of a convertible symbol between one flanking symbol. While it is clear what would be intended by the applicant if the presentation of a convertible symbol was between two flanking symbols it is unclear what the applicant is attempting to describe or encompass through the presentation of a convertible symbol between one flanking symbol.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-7, 9, 11, 13-23, 26, 37, 41-42** are rejected under 35 U.S.C. 102(b) as being anticipated by Yoseloff et al (US 6,311,976).

Claims **1-2, 4-7, 9, 11, 13-23**; Yoseloff teaches a slot machine wild symbol feature including:

a plurality of reels (Figure 1);

a game operable upon a wager by a player(Abstract);

a plurality of symbols including non-wild symbols alternatively described as flanking symbols and non-flanking symbols wherein the non-flanking symbols further comprise a plurality of similar or non-similar convertible symbols alternatively described as wild symbols (Col 11:29-52, 13:30-44); and

a processor (Col 14:37-41) to cause the generation of symbols on each of said reels and when a non-flanking convertible symbol appears on the same active payline as a flanking symbol converting the convertible symbol into a flanking symbol (Figure 5, Element 34), in a manner appreciable to the player, and awarding any reward resultant of the conversion to the player (Abstract Col 11:29-52, 13:30-44).

Claim **3**:Yoseloff teaches associating the flanking and convertible symbols through their presentation (Col 11:29-37).

Claim **26**: The claim language directed to the generation of flanking symbols responsive to the player wager is understood as being taught as the placement of a wager by the player initiate game play in the game of Yoseloff as cited above.

**Claim 37:** In addition to the above the invention of Yoseloff sets forth spinning the reels (Abstract), and as best understood the Applicant's presented claim 24 sets forth steps (a) through (j) as the assignment and re-assignment of symbols to reel positions followed by a singular display step (k). Accordingly the presented claim is understood to describe the process of spinning the reels as set forth by Yoseloff.

**Claims 41-42:** Yoseloff additionally teaches the utilization of a data network including the internet for enabling the realization of the disclosed game system including wild feature (Col 14:25-36 15:1-15).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **10, 12, and 38-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff et al (US 6,311,976) as applied to at least claims **1-27** above, and further in view of Singer et al (US 6,604,740).

Claims **10, 12, and 38-40**: The invention of Yoseloff teaches the invention as taught above however is silent regarding the inclusion of a player designation of symbol type, however in a related game including a wild symbol Singer teaches allowing the player to designate which symbols are and are not treated as wild symbols (Abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the player symbol designation of Singer into the invention of Yoseloff because such a combination would have mere combination of known wild game features in a known and conventional manner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art Unit 3714  
/R. M./  
Examiner, Art Unit 3714  
February 28<sup>th</sup>, 2008